REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-30 and 35-41 are pending in this application. No new matter is added by this paper.

It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. The remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. 35 U.S.C. §103 REJECTIONS

Claims 1-17 and 28 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,055,513 to Katz in view of U.S. Patent No. 6,032,130 to Alloul; claims 18, 19, 29, 35 and 35 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alloul in view of Katz; and claims 20-28, 36-38, 40 and 41 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alloul. The cited documents, either alone or in combination, fail to teach, suggest or provide the requisite motivation for a skilled artisan to practice the instantly claimed invention.

In arriving at this rejection the Examiner has interpreted Katz as disclosing a telemarketing apparatus in which items are purchased via the internet. The Examiner has

interpreted Alloul as disclosing a multimedia vending device in which a user may preview multimedia items on a remote data processing apparatus and purchase these items through an electronic transaction.

Applicants disagree with the Examiner's conclusion that the instantly claimed invention is unpatentable in light of the cited documents. Assuming *arguendo* that Alloul is the closest prior art (as relating to vending multimedia content), Alloul allegedly provides a multimedia catalogue to a terminal and allegedly provides metadata associated with the purchase of that multimedia content via for example the internet. The metadata is what is referred to in Alloul as time variable data related to a selected product (column 3 line 23).

Applicants submit, however, that the instant claims are patentable because Alloul and Katz are defective as evidence of obviousness. For example, neither Alloul nor Katz disclose metadata representing the content of the multimedia material being stored on a multimedia server in association with the multimedia material and does not disclose data defining the vendor of the multimedia material being stored in association with that multimedia material. One of the inventive aspects of the instant invention is to provide a facility for vendors to sell multimedia items efficiently on a server via, for example, the internet. Such an inventive concept is neither taught nor suggested in the cited documents.

The arrangement in Alloul does not disclose an association of metadata describing the content of the multimedia material because there is no requirement for this metadata since the user is reviewing the multimedia material on the CD ROM in order to determine whether to purchase this material. Thus, Alloul does not provide any disclosure of a buyer sending a description identifying generally a class of multimedia material to be purchased to an access

processor which interprets that description to generate metadata to search for multimedia content items in which the buyer may be interested.

Alloul, in column 11 between lines 4 and 14, relates to an arrangement in which multimedia content items are grouped in groups of seasonal products so that catalogue format and/or organizational control data may be downloaded from the transaction server to the client's terminal. Column 11 further goes on to state that "for example this downloaded data may be useful for emphasizing particular products that are best-sellers by placing them on the first page of a catalogue".

Thus, the system disclosed in Alloul envisages presenting the multimedia items stored on the CD ROM to the user for the user to purchase such multimedia content items. It is noted that the terminal of the second embodiment is not a server neither is the public purchasing kiosk according to the first embodiment a server. Since according to the invention the multimedia material is stored on a server, metadata associated with the multimedia material and identification data can be stored in association with the multimedia material and accessed using the metadata. Therefore, Alloul does not provide any teaching of generating metadata from a request for multimedia content from a buyer which can be used by an access processor to recover examples of multimedia material which are within a class identified by that request.

Applicants also note that Katz does not disclose any products that are associated with multimedia material. Thus, although Katz arguably describes purchasing products from the internet and completing a transaction for these products, there is no disclosure of the features of searching for multimedia material based on metadata which describes the content of the multimedia material.

Furthermore, as explained above, one of the inventive concepts of the instant invention is to provide a facility for vendors to sell multimedia material, and such is not disclosed in Katz or Alloul. As a result, the transaction controller is distinguished from the arrangements in Katz and Alloul by the step of communicating an order to a vendor identified by the stored identification information associated with a selected multimedia item to the effect of ordering the selected multimedia content item.

For the Section 103(a) rejection to be proper, both the suggestion and the expectation of success must be found in the prior art, and not in Applicants' own disclosure. In re Dow, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Indeed, hindsight based on Applicants' own success as disclosed and claimed in the present application, is not a justifiable basis on which to contend that the ultimate achievement of the present invention would have been obvious at the time the invention was made. In re Fine, 5 U.S.P.Q.2d 1596, 1599, 1600 (Fed. Cir. 1988).

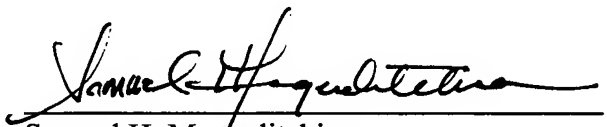
Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. Id. And as "obvious to try" would be the only standard that would lend the Section 103 rejections any viability, the rejections must fail as a matter of law.

Therefore, against this background and in light of the above remarks, the rejections are fatally defective and should be removed. Consequently, reconsideration and withdrawal of the Section 103 rejections are believed to be in order and such actions are respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable, and early and favorable consideration thereof is solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 

Samuel H. Megerditchian
Reg. No. 45,678
(212) 588-0800